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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,812	03/28/2000	Russell W. White	111111.1111	4698

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EXAMINER	
HARRY, ANDREW T	

ART UNIT	PAPER NUMBER
2684	6

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/537,812	Applicant(s) WHITE ET AL.	
	Examiner Andrew T Harry	Art Unit 2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-11,13-16,18-21,23 and 26-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-11,13-16,18-21,23 and 26-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 March 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

The Examiner has received and entered the Applicant's amendment filed December 2, 2002. The Amendment fails to put the application in condition for allowance based on the claim rejections (prior art and other) stated below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 27,31, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "high speed" and "low power" in claims 27, 31, and 34 is a relative term which renders the claim indefinite. The terms "high speed" and "low power" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 35-37 depend from claim 34 and are therefore also rejected as they depend from a rejected independent claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4-11, 13-16, 18-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cerf et al. US Patent 6,418,138** ("Cerf").

As pertaining to **claims 1 and 11**, Cerf describes a system and method for communicating selected information to an electronic device (see Cerf abstract), the system comprising:

a digital engine operable to maintain data associated with selectable audio information, the audio information comprising an audio file (see Cerf col. 3 line 35 – col. 4 line 5, Cerf describes the idea of Internet radio and how it manages audio information, and the user is able to select a specific channel, and clearly if the information transmitted is a file); and

a communication engine communicatively coupled to the digital engine (see Cerf col. 4 lines 6 – 49, in this section Cerf describes how the Proxy server is connected to the internet and acts as a communication engine for the internet to the mobile users.), the communication engine operable to initiate wireless communication of the data to the electronic device (see Cerf col. 5 lines 10 – 28, Cerf describes an example of how the digital audio data is transmitted from the internet through the proxy server out to the wireless mobile user.);

a graphical user interface operably coupled to the digital engine to provide available information to a user of a communication network and to receive an input from the user identifying a selected portion of the selectable information (see Cerf, col. 4 lines 28-50).

wherein the interface operates in a web browsing environment and the wireless communication operates outside the browsing environment (see Cerf, col. 3 lines 35-67).

Cerf does not use the exact terminology that may be used in the instant invention; however, it would have been obvious to one of ordinary skill in the art that the spirit of Cerf's disclosure is similar to that of the claimed invention. To further proceed with prosecution it is suggested that the applicant be more specific with their claims and describe how their "selected audio information" may be different from the selectable channels of audio files (essentially selectable audio information) described by Cerf.

As pertaining to **claims 4 – 10, and 15** Cerf teaches that the audio data is retrieved by a PDA, laptop, or Internet radio via a wireless link between the mobile station and the "radio tower" (see Cerf col. 3 lines 20 – 25 and fig. 2), which is connected to a proxy server which is connected to the internet. Cerf, however, is silent on the wireless method used to transmit the data from the radio tower to the mobile device. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the transmission method that would best fit the design of the system. Some of the transmission methods available at the time of the invention included cellular (which typically used CDMA as a method of transmission), global system for mobile communications (which is operated between 1.7 and 2.0 GHz), or a high-speed low-power microwave wireless link like Bluetooth, which operates around 2.4 GHz. The use of any

of these protocols at the time of the invention would have been obvious to one of ordinary skill in the art based on the design choice of the system designer.

As pertaining to **claim 26**, Cerf describes the characteristics of the wireless devices that are adaptable to be used in his system (see Cerf, col. 4 lines 1-6, this indicates that a cellular phone could be used as all the components described are included in modern cellular telephones).

As pertaining to **claim 29**, Cerf describes that the audio information further comprises streaming audio information (see Cerf, col. 4 line 14).

As pertaining to **claim 30**, Cerf describes that the information is presented in a web-browsing environment (see Cerf, col. 4 lines 28-40).

As pertaining to **claim 13**, Cerf's method further comprises:

presenting information associated with the electronic device (see Cerf col. 5 line 66 – col 6 line 5); and

receiving an input from a user identifying the electronic device (see Cerf col. 6 lines 10 – 14).

As pertaining to **claim 14**, in Cerf's system and method the interface operates in a browsing environment (see Cerf col. 6 lines 23 – 30, Cerf describes that the user is able to look around and retrieve information from the proxy server regarding current broadcast options) and the wireless communication operates outside the browsing environment (see Cerf col. 5 lines 10 – 28).

As pertaining to **claims 16, 18, 19, 28, and 32** Cerf describes an electronic device for receiving selected audio information via wireless communication, the device comprising:

a communication module operable to receive wireless communication of the information (see Cerf col. 1 lines 15 – 27) ;

a RF communication module operably coupled to a processor module (see Cerf, col. 4 lines 1-6, Cerf does not describe specific power characteristics of the terminal, but "low-power" as claimed appears to be quite ambiguous and puts no limitations on the actual power of the device)

Cerf describes that a laptop computer or a PDA may be used as the mobile device in his system to implement his wireless radio concept (see Cerf fig. 2 and col. 5 lines 58 – 61), however Cerf does not specifically describe the capabilities in terms of processing of his mobile device (see Cerf col. 7 lines 10 – 18). However, it would have been obvious to one of ordinary skill in the art at the time of the invention that the laptop computer or PDA would include a storage medium operably coupled to the communication module, the storage medium operable to store the selected audio information and a processor module coupled to the communication module, the processor module operable to process the received selected audio information. It would have been obvious to a skilled artisan at the time of the invention that all laptops and PDAs would include processors capable of processing received data, and memory that would have been capable of storing data that would have been downloaded to these devices. Additionally, is very well known in the art that traditional ways of saving audio files include WAV, MP3, and MIDI formats and the file would be stored in one of these formats. This would have allowed the users of these devices to actually listen to the audio music that they were

downloading and to store the audio information that would have been downloaded to the device so that they may listen to it at a later time.

Cerf's device does have a display opearable to display a web browser within a user interface (see Cerf, col. 4 lines 28-40).

As pertaining to **claim 33**, Cerf describes that the audio information further comprises streaming audio information (see Cerf, col. 4 line 14).

As pertaining to **claim 20**, Cerf's device as modified above in claim 16 further comprises software for processing the selected information (see Cerf col. 7 lines 11 – 18).

As pertaining to **claim 21**, Cerf's device as modified above regarding claims 17 and 23 describes that some of the various transmission techniques that would have been used to transmit the data include CDMA. CDMA is a frequency and time hopped system, and therefore the system would have been capable of scanning the various CDMA frequency channels.

As pertaining to **claim 23,** Cerf as modified above regarding claim 16, teaches that the audio data is retrieved by a PDA, laptop, or Internet radio via a wireless link between the mobile station and the "radio tower" (see Cerf col. 3 lines 20 – 25 and fig. 2), which is connected to a proxy server which is connected to the internet. Cerf, however, is silent on the wireless method used to transmit the data from the radio tower to the mobile device. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the transmission method that

would best fit the design of the system. Some of the transmission methods available at the time of the invention included cellular (which typically used CDMA as a method of transmission), global system for mobile communications (which is operated between 1.7 and 2.0 GHz), or a high-speed low-power microwave wireless link like Bluetooth, which operates around 2.4 GHz. The use of any of these protocols at the time of the invention would have been obvious to one of ordinary skill in the art based on the design choice of the system designer. Also if the device used by the user would be a PDA or laptop computer it would have been obvious to one of ordinary skill in the art at the time of the invention that a cellular or other modem would have been used to receive the transmitted signal.

The following is a second rejection of claims 1 – 25 using an alternative prior art publication.

Claim Rejections - 35 USC § 102

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 11, 13-14, 16, 18 - 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bottum U.S. Patent 6,014,569** (Bottum).

As pertaining to **claim 1**, Bottum describes a system for communicating selected information to an electronic device (see Bottum abstract), the system comprising:

a digital engine operable to maintain data associated with selected audio information (see Bottum fig. 1 item 104 col. 2 lines 63 – 64); and

a communication engine communicatively coupled to the digital engine, the communication engine operable to initiate wireless communication of the data to the electronic device (see Bottum fig. 1 items 110 and 120 and col. 2 line 63 – col. 3 line 20).

a graphical user interface operably coupled to the digital engine to provide available information to a user of a communications network and to receive an input from the user identifying a selected portion of the selectable information (see Bottum, col. 4 lines 1-16); and

wherein the interface operates in a web browsing environment and the wireless communication operates outside the browsing environment (see Bottum, col. 4 lines 23-34)

As pertaining to **claim 29**, Bottum describes that the audio information further comprises streaming audio information (see Bottum, fig. 1).

As pertaining to **claim 11**, Bottum describes a method for communicating selected audio information to an electronic device (see Bottum abstract), the method comprising:

maintaining data associated with the selected audio information using a digital engine (see Bottum fig. 1 item 104 col. 2 lines 63 – 64); and

initiating wireless communication of the data to the electronic device (see Bottum fig. 1 items 110 and 120 and col. 2 line 63 – col. 3 line 20).

presenting information associated with audio information within a graphical user interface associated with a communication network (see Bottum, col. 4 lines 1-16);

receiving an input from a user identifying the selected information (see Bottum, col. 4 lines 1-16);

receiving an input from a user identifying the electronic device (see Bottum, col. 3 lines 54-67);

As pertaining to **claim 30**, Bottum describes that the information is presented in a web-browsing environment (see Bottum, col. 4 lines 1-16).

As pertaining to **claim 13**, Bottum's method further comprises:

presenting information associated with the electronic device; and

receiving an input from a user identifying the electronic device (see Bottum col. 3 line 54 – col. 4 line 16).

As pertaining to **claim 14,** the interface in Bottum's method operates in a browsing environment (see Bottum col. 3 lines 60 – 67, Bottum describes that the user is capable of requesting a menu of available audio options i.e. browsing) and the wireless communication

operates outside the browsing environment (see Bottum fig. 1 items 110 and 120 and col. 2 line 63 – col. 3 line 20, Bottum describes nothing in regards to browsing in regards to the wireless communications).

As pertaining to claim **16**, Bottum describes an electronic device for receiving selected audio information via wireless communication (see Bottum abstract), the device comprising:

a communication module operable to receive wireless communication of the selected audio information (see Bottum col. 2 lines 59 and 60);

a storage medium operably coupled to the communication module, the storage medium operable to store the selected audio information (see Bottum col. 7 lines 33 – 48); and

a processor module coupled to the communication module, the processor module operable to process the received selected audio information (see Bottum col. 3 lines 15 – 32, the laptops obviously contain both processing and memory capabilities that may be used with the receiver).

As pertaining to **claim 18,** Bottum's device could be a handheld computing device (see Bottum fig. 2, and col. 3 lines 20 – 32, a laptop is also considered a hand-held device).

As pertaining to **claim 20,** Bottum's device further comprises software for processing the selected information (see Bottum col. 3 lines 26 – 30).

As pertaining to **claim 21,** the communications module in Bottum's device is operable to scan frequencies (see Bottum col. 13-16).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4 – 10, 15, 19, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bottum.

As pertaining to **claims 4 – 10, 15, and 23** Bottum teaches that the audio data is retrieved by a PDA/ laptop, or Internet radio via a wireless link between the mobile station and the wireless service provider, and Bottum describes that that service could be various different types of wireless service an equipment (see Bottum fig. 1 items 110 and 120 and col. 2 line 63 – col. 3 line 31). Bottum however, does not disclose all possible wireless methods that could be used to transmit the data from the radio tower to the mobile device. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the transmission method that would best fit the design of the system. Some of the transmission methods available at the time of the invention included cellular (which typically used CDMA as a method of transmission), global system for mobile communications (which is operated between 1.7 and 2.0 GHz), or a high-speed low-power microwave wireless link like Bluetooth, which operates around 2.4 GHz. The use of any of these protocols at the time of the invention would have been obvious to one of ordinary skill in the art based on the design choice of the system designer.

As pertaining to **claim 19**, Bottum's device describes that it is possible to use a laptop with a cellular modem to receive the requested audio signal (see Bottum col. 3 lines 15 – 20), however Bottum does not disclose specifically that a PDA may be used to download the digital audio data. It would have been obvious to one of ordinary skill in the art at the time of the invention to know that a PDA possessed the same basic functionalities as a laptop computer and that given a users specific needs they could have used a PDA with a cellular modem to download and process the digital music in a similar manner as would have been accomplished in a laptop computer. The smaller PDA would have allowed the user to be significantly more mobile and to take the device places that a laptop may have been an inconvenience.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

As an additional note the Examiner would like to state that major claim modifications will be needed to allow the Applicants invention to overcome the prior art made of record. The Applicants may consider spotlighting **specifically** in their claims how their invention is distinct from the Cerf and Bottum references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Harry whose telephone number is 703-305-4749. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

ATH
December 26, 2002

DANIEL HUNTER
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